2621

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte FREDERICK J. COOPER, RANJIT R. MENON, TERESA L. URUTIA, GIRISH GOPAL, KEITH E. HOPPER, and BLAKE R. BENDER

Appeal No. 2005-1047
Application No. 09/430,282

ON BRIEF

Before CRAWFORD, GROSS, and BLANKENSHIP, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20, 22 to 25 and 27, which are all of the claims pending in this application. Claims 1 to 19, 21, 26, and 28 to 30 have been canceled.

The appellants' invention relates to a processor-based system controlled using a digital camera. The digital camera provides luminance and motion information which may be analyzed to determine whether to alter one or more of the power consumption states of the system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Choi	5,986,695	Nov. 16, 1999
Ye et al. (Ye)	6,384,852 B1	May 7, 2002
Christian et al. (Christian)	6,400,830 B1	Jun. 4, 2002

THE REJECTION

Claims 20, 22 to 25 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ye in view of Choi.[1]

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[1] The examiner has withdrawn the rejection of the claims pursuant to 35 U.S.C. § 102 as anticipated by Christian (answer at page 40). The examiner has not repeated the rejection pursuant to 35 U.S.C. § 112, second paragraph which was in the final rejection. Therefore, this rejection is presumed to have been withdrawn as well.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed Jul. 15, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (filed Apr. 24, 2003) and reply brief (filed Jul. 28, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection in this case is made pursuant to 35 U.S.C. § 103. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The examiner relies on Ye for teaching using image information to detect any movement in front of a camera and controlling the power of the computer based on the detected movement (col. 2, lines 52 to 67; Fig. 2). Recognizing that Ye does not disclose controlling the power consumption state of the system based at least in part on luminance information, the examiner relies on Choi.

Choi teaches that the recording medium of a security system which includes a camera can be conserved by checking whether a recording of a volume of surveillance contains a motion component and recording a subsequent interval of surveillance over an earlier recording when the motion component of the earlier recording shows little or no motion (col. 2, lines 9 to 13). The motion is detected by sampling luminance signals every predetermined time period, converting the luminance signals to digital data, and storing this data in memory. The stored values are compared to determine the amount of motion (col. 4, lines 33 to 38).

The examiner reasons that one of ordinary skill in the art would recognize that the additional step of converting Red, Green, and Blue color values into luminance values involves simple and negligible calculations compared to the subtraction and addition calculations as taught by Ye which describes subtraction calculations requiring three color component values of different images. The examiner finds that Ye requires more system resources such as memory and computation power. The examiner concludes:

> . . . Choi's teaching of a simple, efficient, and accurate method to detect a motion in a video image using luminance levels would motivate one of ordinary skill in the art to modify Ye et al[.]'s method of using three color components, RGB, to detect a motion in a video image with Choi's teaching of using only a luminance component to detect a motion in a video image. Such modification would enable a simpler and faster way to detect a motion in a video image, thereby, saving system resources and computation power. [Answer, page 6.]

We will not sustain this rejection because the examiner has not established a prima facie case of obviosuness. When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986-87, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GMBH v. Am. Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the present case, the examiner has not directed our attention to any teaching in the prior art that would have motivated a person or ordinary skill to combine the teachings of Ye which is directed to a invention which utilizes motion to detect the presence of a user so as to operate a computer screen saver, and the teachings of Choi which is directed to conserving recording medium by recording over an earlier recording when it is determined by luminance detection that there is no motion recorded on the earlier recording.

The examiner's rationale for the combination, made for the first time in the answer, is not based on the teachings or suggestions in the prior art and as such is not sufficient to establish a prima facie case of obviousness.

The decision of the examiner is reversed.

REVERSED

MURRIEL E. CRAWFORD
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

) BOARD OF PATENT APPEALS AND INTERFERENCES

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